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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/620,549	07/16/2003	Peter Seitz	13027.43US01	8444
23552	7590	09/20/2005	EXAMINER	
MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903			DICUS, TAMRA	
		ART UNIT		PAPER NUMBER
				1774

DATE MAILED: 09/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/620,549	SEITZ, PETER
	Examiner	Art Unit
	Tamra L. Dicus	1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is **FINAL**.                                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-12 is/are pending in the application.
  - 4a) Of the above claim(s) 12 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-11 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date: _____
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>08-13-04</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____.

## **DETAILED ACTION**

Acknowledgement is made of the IDS.

### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-11, drawn to an identification device classified in class 428, subclass 195.1.
  - II. Claim 12 is drawn to a method of manufacturing an identification device classified in class 427, subclass 100.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the device of I can be made by placing a pressure of a hand or foot to make a pattern with ink and/or eliminating the step of storing the pattern or via printing the image of the pattern.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Greg Simons on 9/8/05 a provisional election was made with traverse to prosecute the invention of I, claims 1-11. Affirmation of this election must be made by applicant in replying to this Office action. Claim 12 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claims refer to a pressure-distribution pattern and a two-dimensional sampling. However, neither term is described with enough detail to show or explain how the application of the identification device or the device itself is produced, specifically no description exists on

how patterns are formed or obtained by taking “the means of the pressures”, or during walking, sitting, grabbing, or what the “special method” is or how “different high pressures are represented by area elements that are shaded in different ways or colors” or “a movement sequence is abolished”. For example, see Applicant’s specification at page 3, line 10-33, and page 5, line 26. It is not clear what method is used to produce the patterns or sampling. Thus, one skilled in the art would not know how to make the invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims recite a “pressure-distribution pattern”, a “two dimensional sampling”, and that a movement sequence is abolished or how an application of an identification device as claimed wherein said pattern is obtained from a person who uses the identification device; this language is not clear and there is no definition within the specification or claims. It is unclear as to what applicant intends from the language as claimed as recited in claims 1-11.

Claims 4-5 and 9-11 recites the limitations “the body part”, “the movement sequence”, “the sitting surface”, “the hand”, “the person”. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, and 4-11 are rejected under 35 U.S.C. 102(b) as being anticipated by USPN 4,960,749 to Miura et al.

Miura teaches a colored concavo-convex pattern such as a fingerprint, thumbprint, foot shape, hand shape applied to cloths or a sheet such as an acid sheet or a commercially available noncarbon copying paper (col. 2, lines 1-15, col. 4, lines 39-51, col. 5, lines 35-68, and Examples 1-2). The fingerprint is pressed onto and transferred to the sheet printed with printing ink via thermogravure printing or thermo-flexographic printing (equivalency to a pressure-distribution pattern and an image printed on an item by a thermotransfer process). Claims 1, 4-7, and 8-11 are met. Identification is inherent because every human fingerprint is naturally made this way.

Further regarding claims 8-11, how the pressure-distribution pattern is obtained via walking, or sitting, or grasping, is a product by process limitation. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113). Furthermore, the invention defined by a product-by-process invention is a product NOT a process. *In re Bridgeford*, 357 F. 2d 679. It is the patentability of the product claimed and NOT of the recited process steps which must be established. *In re Brown*, 459 F. 2d 531.

The same process and materials of the instant product are provided by the prior art, and are hence considered equivalent.

Further to claims 1 and 8-11, that the identification device is for individualizing a item or is to be worn or is for the purpose of identifying, this language is intended use and is not germane to patentability. Therefore, the Examiner interprets “an identification device” as an identification device, not requiring individualizing or worn on a person’s body, because the same materials are used (if the prior art consists of an identification device, then it is capable of being worn on a persons body and individualized). The phrase as written, in its broadest interpretation, does not require individualizing or being worn on a body, as it is capable of doing so on its own due to the same materials it is comprised of.

Further regarding claim 5, the mean and peak values obtained during movement is inherent as a hand moves toward its paper or cloth object to imprint the fingerprinted image.

Claims 1, and 4-11 are rejected under 35 U.S.C. 102(b) as being anticipated by USPN 5,454,600 to Floyd.

Floyd teaches an identification label having a fingerprint thereon substrates such as fabric, plastic, an article of clothing such as a shirt, or similar materials (equivalent to substantially solid object and cloth, col. 3, lines 25-28, col. 4, line 35). The printed fingerprint is made by an inked child’s finger and applied to a designed label, ironed on a shirt for the purpose of identifying the child during an abduction. Such description is equivalent to a pressure-distribution pattern and an image printed on an item by a thermotransfer process. See col. 1, lines 5-20 and lines 40-65, col. 2, line 3, lines 20-35. Claims 1, 4-7, and 8-11 are met.

Further regarding claims 8-11, how the pressure-distribution pattern is obtained via walking, or sitting, or grasping, is a product by process limitation. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113). Furthermore, the invention defined by a product-by-process invention is a product NOT a process. *In re Bridgeford*, 357 F. 2d 679. It is the patentability of the product claimed and NOT of the recited process steps which must be established. *In re Brown*, 459 F. 2d 531. The same process and materials of the instant product are provided by the prior art, and are hence considered equivalent.

Further to claims 1 and 8-11, that the identification device is for individualizing a item or is to be worn or is for the purpose of identifying, this language is intended use and is not germane to patentability. Therefore, the Examiner interprets “an identification device” as an identification device, not requiring individualizing or worn on a person’s body, because the same materials are used (if the prior art consists of an identification device, then it is capable of being worn on a persons body and individualized). The phrase as written, in its broadest interpretation, does not require individualizing or being worn on a body, as it is capable of doing so on its own due to the same materials it is comprised of.

Further regarding claim 5, the mean and peak values obtained during movement is inherent as a hand moves toward its paper or cloth object to imprint the fingerprinted image.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 4,960,749 to Miura et al.

Miura essentially teaches the claimed invention.

Miura does not explicitly teach high pressures are represented by area elements that are differently colored or shaded in different ways.

However, Miura does teach at col. 4, lines 30-40 the fingerprint image pattern is formed of ink using white and coloring pigment, where the fingerprinted portion is printed with the ink to emphasize the fingerprint.

It would have been obvious to one having ordinary skill in the art to have different pressures, colors, or shading in different ways because Miura teaches a selection of pigments used in the fingerprint image pattern, formed of ink using white and coloring pigment, where the fingerprinted portion is printed with the ink to emphasize the fingerprint (at col. 4, lines 30-40 of Miura). Further, it would have been obvious to include varying pressures as it is depended upon the force of a person's hand when inking their individual and unique fingers to produce their fingerprint.

Claims 2-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,454,600 to Floyd.

Floyd essentially teaches the claimed invention.

Floyd does not explicitly teach high pressures are represented by area elements that are differently colored or shaded in different ways.

However, Floyd does teach at col. 4, lines 15-26 the fingerprint image pattern is formed of a texture to be camouflaged or disguised within the background print, where the fingerprinted portion is printed on top with an image of a dinosaur egg.

It would have been obvious to one having ordinary skill in the art to have different pressures, colors, or shading in different ways because Floyd teaches a fingerprint pattern is adjusted to blend into, disguise or camouflage into various backgrounds in the form of rabbits, or dinosaurs, or an infinite array of illustrations, images, or scenes to aid in locating missing children (col. 1, lines 1-21 and col. 4, lines 15-35 of Floyd). Further, it would have been obvious to include varying pressures as it is depended upon the force of a child or adult's hand when inking their individual and unique fingers to produce the fingerprint.

***Prior Art of Interest***

USPN 5,078,426 to Reardon teaches a fingerprint recording device.

USPN 5,473,144 to Mathurin, Jr. teaches a fingerprint on a credit card.

USPN 6724689 to Koenig teaches a handprint made via a device.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is 571-272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Tamra L. Dicus  
Examiner  
Art Unit 1774

September 8, 2005



RENA DYE  
SUPERVISORY PATENT EXAMINER  
A.U.1774 9/14/03